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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
ISAO TSURU, ET AL. : EXAMINER: SHOSHO, CALLIE E
SERIAL NO: 10/633,705 :
FILED: AUGUST 5, 2003 : GROUP ART UNIT: 1714
FOR: WATER-BASED INK :

PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Responsive to the Advisory Action of January 29, 2007 and the final Office Action of September 8, 2006 and further to the Amendment filed on January 8, 2007, Applicants request pre-appeal review of the rejections in the above-identified application.

Remarks begin on page 2 of this paper.

REMARKS

Applicants submit that the rejection of the presently pending claims as obvious under the meaning of 35 U.S.C. § 103(a) in view of Nakano (U.S. 6,740,690) in combination with Tabayashi (U.S. 6,074,467) contains clear legal and factual errors meriting withdrawal of the rejections and the allowance of all now-pending claims.

The claims of the present application require the presence of at least two alkylene oxide-containing monomers having different alkylene oxide groups. See components (A) and (B) of Claim 1 which have different alkylene oxide groups.

The Office asserts that Nakano discloses a composition that must contain monomers (a), (b), (c), (d), and (e) and therefore suggests the compositions of the present claims, i.e., the Office asserts that Nakano suggests or discloses a composition that includes the ethylene oxide-containing monomer of formula (A) and the propylene oxide-containing monomer of formula (B) of present Claim 1. See page 2, lines 10 through page 3, line 8 of the January 29 Advisory Action. It appears that it is the Office's opinion that the compositions of Nakano must contain two alkylene-oxide containing monomers having different alkylene oxide groups because Nakano discloses a composition that may contain monomers (a)-(e).

Applicants submit that Nakano's disclosure of compositions that contain monomers (a)-(e) is not a disclosure or suggestion that the prior art composition must contain two alkylene oxide-containing monomers having different alkylene oxide groups. Applicants further submit that Nakano does not recognize any criticality associated with using two alkylene oxide containing monomers having different alkylene oxide groups.

According to the Office, Nakano discloses a monomer (d) that is a hydroxy group-containing monomer and a monomer (e) that is an alkylene oxide-containing monomer. From this disclosure the Office concluded that Nakano discloses compositions that must contain

two different alkylene oxide-containing monomer units. See the sentence bridging pages 2 and 3 of the January 29 Advisory Action. The Office's logic in this regard is not correct because monomers (d) and (e) do not necessarily contain different alkylene oxide groups.

The Office appears to place great weight on Nakano's disclosure that monomer (d) can be a polyethylene glycol (meth)acrylate and monomer (e) can be a polypropylene glycol monomethacrylate. See page 4, lines 13-17 of the January 29 Advisory Action and column 5, lines 40-53 and column 10, lines 1-6 of Nakano. The Office overlooks an important point in this comparison. Nakano's monomer (d) may be a polyethylene glycol-containing monomer unit or a polyethylene/propylene glycol monomer unit, or any of a group of other monomer species, some of which are not alkylene oxide-containing monomer units. See column 10, lines 1-6 of Nakano. Similarly, Nakano's monomer (e) may be a polyethylene glycol or a polypropylene glycol. See column 5, lines 40-53 of Nakano.

Thus, contrary to disclosing that the prior art compositions must contain at least two alkylene oxide-containing monomers having different alkylene groups, Nakano discloses that monomers (d) and (e) may have the same alkylene groups (e.g., both (d) and (e) may be ethylene oxide-, propylene oxide- or ethylene/propylene oxide-containing monomers).

The Office's assertion that Nakano discloses compositions that require the presence of two alkylene oxide-containing monomer units having different alkylene oxide groups is not correct because monomers (d) and (e) may have the same alkylene oxide groups. Therefore, the rejection is not supportable and should be withdrawn.

Moreover, Nakano does not recognize the criticality of using two alkylene oxide-containing monomer units having different alkylene oxide groups. This point was argued at length in the Amendment filed on January 8, 2007. See page 8, lines 16-20 and page 11, lines 4-15 of the Amendment filed on January 8, 2007. Contrary to the Office's assertion on

page 4, lines 4-8 of the Advisory Action, Nakano does not recognize the criticality of using alkylene oxide-containing monomer units that have different alkylene oxide groups at least because Nakano discloses that ethylene oxide- and propylene oxide-containing monomer units may be used interchangeably.

Further, on page 4, lines 13-15 of the January 29 Advisory Action, the Office asserts that Nakano discloses that it is favorable to use a polyethylene glycol (meth)acrylate and a polypropylene glycol (meth)acrylate. Applicants submit that this is not correct. Nakano discloses that monomer units other than polyethylene glycol (meth)acrylates may be used as component (d). See column 10, lines 1-6 of Nakano. Monomer unit (d) may contain any of an ethylene oxide, a propylene oxide, or an ethylene/propylene oxide group. Thus, the Office is factually incorrect in asserting that component (d) of Nakano must be an ethylene oxide-containing monomer unit. In fact, monomer(d) contains an alkylene oxide group that is not necessarily different from the alkylene oxide group of monomer (e).

The Office further asserts that the data submitted in support of patentability is not commensurate in scope with the claims. See page 4, lines 4-8 of the Advisory Action. As stated above, and as argued on page 8, line 21 through page 11 of the Amendment of January 8, 2007, the data of the original specification and the data of the Declaration submitted on June 12, 2006 show the criticality of using at least two alkylene oxide-containing monomer units having different alkylene oxide groups.

Nakano does not recognize any criticality associated with using at least two alkylene oxide-containing monomer units having different alkylene oxide groups. In fact, as explained above, Nakano treats ethylene oxide- and propylene oxide-containing monomer units as equivalents. Nakano does not explicitly disclose a composition having two alkylene oxide-containing monomer units having different alkylene oxide groups nor does Nakano disclose

that any advantage may be obtained by using at least two alkylene oxide-containing monomer units having different alkylene oxide groups.

Applicants' data show that using at least two alkylene oxide-containing monomer units having different alkylene oxide groups provides inks of significantly different angular dependency of color tone in comparison to compositions that contain only a single alkylene oxide-containing monomer unit. See Table 1 and the explanation following Table 1 on page 9 of the Amendment filed on January 8, 2007.

Thus, Applicants have shown that compositions containing at least two alkylene oxide-containing monomer units having different alkylene oxide groups are unobviously different from prior art compositions which treat ethylene, propylene, and ethylene/propylene oxide-containing monomer units as equivalents.

For the reasons stated above, Applicants submit that the rejection of the claims should be withdrawn and all now-pending claims should be allowed.

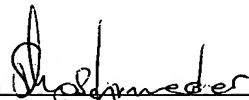
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 03/06)



Stefan U. Koschmieder, Ph.D.
Registration No. 50,238

NFO/SUK/law